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OFFICE OF PETITIONS

In re Application of :
Lesch Jr. et al. :
Application No. 10/603,235 :
Filed: June 24, 2003 :
Attorney Docket No. NWK1581 :

ON PETITION

This is a decision on the second renewed petition under 37 CFR 1.137(a), filed May 19, 2008, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

On June 28, 2005, the Office mailed a Corrected Notice of Allowance and Fee(s) Due and Notice of Allowability, (hereinafter "Notice of Allowance") which set a three-month statutory period for reply. The Notice of Allowance indicated that applicant must pay a \$700.00 issue fee by September 28, 2005, to avoid abandonment. In the absence of a timely filed reply, the application became abandoned on September 29, 2005. A Notice of Abandonment was mailed on May 26, 2006. On November 6, 2006, applicant filed a petition under 37 CFR 1.137(a), which was dismissed by the decision of May 21, 2007. On July 20, 2007, applicant filed a renewed petition under 37 CFR 1.137(a), which was dismissed by the decision of July 24, 2007. On May 19, 2008, applicant filed the present second renewed petition under 37 CFR 1.137(a).

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed.
- (2) The petition fee as set forth in 37 CFR 1.17(l);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to § 1.137(d).

This second renewed petition lacks item (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable". Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Applicant asserted that the delay was unavoidable due to non-receipt of the Notice of Allowance mailed on June 28, 2005. Applicant stated that prior to the filing of the application counsel relocated and updated the customer number to reflect the new address. Specifically, applicant asserted:

It is first noted that the original Utility Patent Application Transmittal sheet, filed 6/24/2003 via US Express Mail Label No. EU187567775US clearly indicated for the application correspondence address to be that associated with Customer Number 30245. The remaining question concerns when the address for that customer number was properly updated in 2003. Attorney shows by preponderance of the above evidence that the Customer Number address for 30245 was updated prior to the Notice of Allowance for the file at issue was mailed.

A belated notification to the USPTO of a change of correspondence address does not constitute proper notification as to establish unavoidable delay. An applicant is responsible for promptly informing the Office of any change of address. Furthermore, where an application becomes abandoned as a consequence of a change of correspondence address an adequate showing of “unavoidable” delay requires a showing that applicant exercised due care to promptly notify the Office of the change of address and file a timely notification of the change of address in the application at hand. MPEP 711.03(c)(III)(C)(2). Furthermore, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an “unavoidable” delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

As stated in the previous decision, the Office noted that the Notice of Allowance was returned to the Office with an indication on the envelope to “RETURN TO SENDER NOT DELIVERABLE AS ADDRESSES UNABLE TO FORWARD.” The Office further noted that the declaration and transmittal letter submitted on filing included the Customer Number 30245, as well as the typed correspondence address of 6721 Northridge Drive, Dallas, Texas 75214-3156. The decision reminded applicant that applicant bears the burden of establishing that a timely change of correspondence address was submitted with the Office. The Office informed applicant that a review of the USPTO records revealed that a change of the correspondence address was entered by the USPTO on June 14, 2006, after the mail date of the Notice of Allowance, and thus, it appeared that the Notice was mailed to the address of record, as it existed on June 28, 2005.

The decision of May 21, 2007, stated that applicant must provide documentary evidence, such as (1) a copy of the “Request for Customer Number Data Change ” (PTO /SB /124), requesting a change in the correspondence address associated with Customer No. 30245; (2) a copy of the “Change of Correspondence Address, Application ” (PTO /SB /122), changing the correspondence address of this application to the address associated with Customer No. 30245; or (3) a copy of a request submitted electronically via a computer-readable diskette to change the correspondence address of this application to the address associated with Customer No. 30245, to demonstrate that applicant changed the correspondence address associated with Customer No. 30245 to PO Box 160370, Austin TX 78716-0370, prior to the mailing of the Notice of Allowance of June 28, 2005.

In the first renewed petition, the practitioner asserted that the “[a]ttorney shows by preponderance of the above evidence that the Customer Number address for 30245 was updated prior to the Notice of Allowance for the file at issue was mailed.” *Renewed Petition*, p. 2. However, neither applicant nor the practitioner submitted any documentary evidence with the renewed petition, as requested in the decision of May 21, 2007, to support this assertion. Accordingly, the renewed petition was dismissed by the decision of January 17, 2008.

On May 19, 2008, applicant filed the present second renewed petition. The practitioner argues: “Where an action is returned as undeliverable, the office must attempt to ascertain the correct address and re-mail the action, with the period being reset with the date of re-mailing.” In support, the

practitioner cites to In re Gourtoff, 1924 C.D. 153, 329 O.G. 536 (Comm'r Pat. 1924). Furthermore, the practitioner asserts:

The Office neither selected the Customer Number address, which was updated in a timely manner, nor attempted to ascertain the correct address when it was returned as undeliverable. Attorney used due care to take all action necessary for proper response to outstanding Office actions, but could not respond to an Action that was unknown to Attorney because the Office did not follow its own procedures.

The Office notes that Office actions or Notices are sometimes returned to the Office because the USPTO is unable to deliver them. Upon receipt of the returned Office action or Notice, it is the procedure of the USPTO to have the Technology support staff checks the application record to ensure that the Office action or Notice was mailed to the correct correspondence address. See MPEP 703.01. The support staff should remail the Office action or Notice to the correct correspondence address with a remailing date. Id. The period running against the application begins with the date of remailing. If the Office is not successful in delivering the Office action or Notice, a copy of the communication and a copy of the envelope should be added to the Image File Wrapper. If the period dating from the remailing elapses with no communication from applicant, the application is abandoned.

In the present second renewed petition, the practitioner cites to 37 CFR 1.33(a), which states: "If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address." It appears that the practitioner mistakenly believes that the Office entered the typed correspondence address over the address associated with the Customer Number.

In both the declaration and transmittal letter submitted on filing the application, the practitioner specified Customer Number 30245, as well as the typed correspondence address of 6721 Northridge Drive, Dallas, Texas 75214-3156. Therefore, in keeping with 37 CFR 1.33(a), the Office selected the address associated with the Customer Number over the typed correspondence address. However, the Office notes that address associated with Customer Number 30245 and the typed correspondence address (6721 Northridge Drive, Dallas, Texas 75214-3156) were the same at the time of the mailing and remailing of the Notice of Allowance. The records show that the practitioner did not submit a timely request with the USPTO to update the Customer Number address or to associate the updated address with this application. Moreover, the Office again notes that neither applicant nor the practitioner submitted any documentary evidence with the present second renewed petition, as requested by the USPTO, to support the assertion the Customer Number address for 30245 was updated prior to the date of mailing of the Notice of Allowance.

The Office correctly followed its procedures by entering the address associated with the Customer Number as the correspondence address of record over the typed address and correctly mailed the Notice of Allowance to the Customer Number address (6721 Northridge Drive, Dallas, Texas 75214-3156) as it existed on that date. Upon receiving the returned Notice of Allowance, the support staff verified that the Notice of Allowance was mailed to the correct correspondence address as it existed in the USPTO records at that time. The Office remailed the Notice of Allowance to the correspondence

address of record and restarted the period for reply. As no timely reply was received in the USPTO, the application became abandoned.

After a thorough review of all of the facts, the Office concludes that applicant did not submit a timely request to change the address associated with the Customer Number to PO Box 160370, Austin, TX 78716-0370 or designate a new address associated with the Customer Number as the correspondence address of instant application. Accordingly, applicant failed to demonstrate that the delay in paying the issue fee was unavoidable.

In view of the above, the second renewed petition under 37 CFR 1.137(a) is dismissed. Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. If applicant should file a petition for reconsideration, it should include an exhaustive attempt to provide the lacking item(s) noted in the decision because the Director will not undertake any further reconsideration or review of the matter after a decision on the petition for reconsideration. Specifically, as indicated above, applicant must provide documentary evidence, such as (1) a copy of the "Request for Customer Number Data Change" (PTO /SB /124), requesting a change in the correspondence address associated with Customer No. 30245; (2) a copy of the "Change of Correspondence Address, Application" (PTO /SB /122), changing the correspondence address of this application to the updated address associated with Customer No. 30245; or (3) a copy of a request submitted electronically via a computer-readable diskette to change the correspondence address of this application to the updated address associated with Customer No. 30245, to demonstrate that applicant changed the correspondence address associated with Customer No. 30245 to PO Box 160370, Austin TX 78716-0370, prior to the mailing of the Notice of Allowance of June 28, 2005.

In the alternative, the Office strongly advises applicant to file a petition under 37 CFR 1.137(b). The provisions of 37 CFR 1.137(b) provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
 - (2) The petition fee as set forth in 37 CFR 1.17(m) (currently \$810.00 for a small entity); and,
 - (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Correspondence may also be submitted via the Electronic Filing System of the USPTO.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

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